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Lawrence C. Cole

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04/01/2009

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EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

04/01/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/904,061 | Applicant(s) COLE ET AL. | |
| | Examiner Corbett B. Coburn | Art Unit 3714 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 11-19, 22-25, 27-33, 35-44 & 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Acres (US Patent Number 6,312,333).

Clams 11, 12, 14, 16, 17, 24, 25, 28, 29, 36, 37, 39, 41, 42: Claims 11, 12, 14, 16, 17 are clearly anticipated by Acres – See Figs 1-3 & Summary of the Invention.

Acres teaches enabling payout to the player of all winnings including all winnings over the threshold amount during the reduced interruption gaming session. (Col 6, 50 – Col 7, 6) At Col 6, 59-63, Acres clearly indicates that there will be cases where no money is withheld. Acres teaches that, “The payment amount is determined by the amount won and the withholding amount if any. If a withholding amount is specified, it

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is deducted from the amount paid. In some cases, the protocol will not contain such a command.” (Emphasis added.) Acres also teaches that the system may “Immediately approve the award and make payment.” (Col 6, 50) Examiner takes this to mean that the winnings are paid immediately – without waiting until the jackpot related information statement is generated. This means that the player continuously maintains access to all winnings. Thus any winnings on the credit meter are subject to immediate cash out.

In the case where there is an immediate payout is a result of the player pressing the cashout button on the slot machine, the statement would be generated after the reduced interruption gaming session is terminated. Clearly, the player has the option of continuing to play the reduced interruption gaming session as desired.

Claims 13, 38: Acres teaches that the database contains all the information necessary to complete the W2-G. (Col 5, 28-31) This inherently includes the player’s name, address & tax identification number.

Claims 15, 40: Fig 2 shows a gaming machine (12) with a microprocessor (52) that is programmed with the protocol necessary to carry out uninterrupted play – i.e., play without intervention of casino personnel.

Claims 18, 43: Acres discloses a number of keys or buttons such as the spin button (53) and coin-in button (Col 4, 46), etc. This is essentially a keypad.

Claims 22, 27, 35, 47: Acres discloses that the gaming machine is in a casino. Thus physical access to the gaming machine is limited to casino patrons. Casino patrons are given physical access to the gaming machines.

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Claim 23: Acres teaches a computer network that must inherently include a computer program product. This program enables the network to allow for an uninterrupted play session on a gaming machine even when a reportable jackpot is won – i.e., no intervention by casino personnel is required. There is code to enable a central storage computer to store player related information (88) There is code to allow a gaming machine to enter uninterrupted play in response to user input – insertion of card (66) into card reader (60). There is code to enable the gaming machine to send signals representing jackpot-related information to the central storage computer (44), which is receive and recorded whenever a reportable jackpot is won. There is code to enable the gaming machine to communicate to the central computer that an uninterrupted session has ended (i.e., the cash out signal). There is code to allow the central computer to generate a statement including player-related information and jackpot-related information (i.e., W2-G) after an uninterrupted session has ended. (Col 7, 33-43)

Acres teaches enabling payout to the player of all winnings including all winnings over the threshold amount during the reduced interruption gaming session. At Col 6, 59-63, Acres clearly indicates that there will be cases where no money is withheld. Acres teaches that, “The payment amount is determined by the amount won and the withholding amount if any. If a withholding amount is specified, it is deducted from the amount paid. In some cases, the protocol will not contain such a command.” (Emphasis added.) Acres also teaches that the system may “Immediately approve the award and make payment.” (Col 6, 50) Examiner takes this to mean that the winnings are paid immediately – without waiting until the jackpot related information statement is generated. Since

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Acres' invention is implemented on a computer, there must inherently be code to carry out the described function.

Claim 30: Acres teaches gathering information necessary to complete IRS Form W2-G. IRS regulations require the casino to fill out Form W2-G for certain jackpots. The instructions for the form require identification numbers from a driver's license, social security card, or voter registration to be inserted into boxes 11 & 12 of the Form W2-G. Thus looking at these documents is inherently required by Acres' disclosure.

Claim 31: Acres teaches filing the W2-G. (Col 6, 26-28)

Claim 32: The W2-G is a statement of the jackpot-related information. It is provided to the player.

Claims 19, 33: Since the game machines can play an uninterrupted game, they must be enabled to execute a protocol putting the gaming machine in uninterrupted mode.

Claim 44: The protocol for uninterrupted play is inherently capable of being activated by an enabling event. Some event must enable the described process to take place. This event is, by definition, an enabling event.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2 & 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (US Patent Number 5,505,461) in view of Acres (US Patent Number 6,312,333).

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Claim 1: Bell teaches a method of allowing a United States-taxable player to participate in an uninterrupted gaming session when a jackpot over a threshold amount is won on a slot machine. (Col 3, 58-60) Bell teaches collecting and storing player-related information. (Col 5, 39-42) Bell teaches recording the jackpot-related information whenever a jackpot greater than a threshold amount is won and crediting winnings to the player. (Col 3, 30-42) Bell also teaches generating a statement referencing the recorded jackpot information and player information after the player is done playing. (Col 4, 43-60) Bell teaches ensuring that the player continuously maintains access to all winnings, including all winnings over the threshold amount. The amounts are recorded on the IRS meter and the player may use them to make additional wagers. (Col 3, 25-55 & Col 4, 27-38) Bell teaches recording the nationality of the player so that money will not be withheld in cases where IRS rules do not apply. (Col 5, 43-47) Naturally, if no taxes are withheld, no reduction is made to the winnings and the player receives all winnings over the threshold amount. Bell clearly has the ability to make instantaneous payouts for amounts over the threshold amount. Bell teaches generating a statement upon termination of the gaming session. (Col 3, 47-49) Bell teaches use of player tracking cards, but fails to teach the details of the system. Player tracking systems are extremely well known to the art. They allow casinos to keep track of player activities so that the casinos can tailor their marketing to patron requirements. Acres teaches a tracking device having a central server that is connected to the gaming machine. (Fig 2, 60) & Col 2, 1-10) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell to include a tracking device having a central server

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that is connected to the gaming machine as taught by Acres in order to carry out Bell's teaching of using a player tracking system and to allow casinos to keep track of player activities so that the casinos can tailor their marketing to patron requirements.

Bell also fails to teach enabling the payout before the jackpot related information statement is generated. Acres teaches that with a player tracking system, it is possible to immediately approve the award and make payments. (Col 6, 50) Since the W2-G form is generated by a processor that is not on the gaming machine, this means that the player does not have to wait until the form is actually printed before receiving the winnings. This adds to player convenience. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell in view of Acres to enable the payout before the jackpot related information statement is generated in order to add to player convenience.

As pointed out above, Bell teaches obeying IRS rules for making payments. To the extent that immediate payouts of cash amounts over the threshold amount are permitted by law, Examiner believes that Bell would make those payments. Acres, however, explicitly teaches making immediate payouts over the threshold amounts. (Col 6, 50- Col 7, 6) Acres makes it clear that this is done in cases where it is legal to do so. This immediate payout provides the player with his money in a timely manner. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell (to the extent that any modification is necessary) in view of Acres to provide an immediate payout of any winnings over the threshold amount in order to provide the player with his money in a timely manner.

Regarding the newly added limitation, as pointed out immediately above, Acres teaches immediate payout of any winnings. Thus Acres teaches that payout of any winning to the credit meter is subject to immediate cash out.

Claim 2: Bell's preprogrammed gaming machine is allowed to play an uninterrupted game even if a reportable jackpot is won. (Col 3, 58-60)

Claim 4: Bell's player is given physical access to the game of chance dedicated to uninterrupted play. (Fig 1) The player actually gets to touch the slot machine to pull handle (14).

Claim 5: Bell teaches verifying a player's identity and citizenship. (Col 5, 19-25) While the method of doing so is not stated, this could not be done without viewing documents that qualify as proof of the player's identity.

Claim 6: Bell teaches gathering tax-related information from the player. (Col 5, 19-25)

Claim 7: Bell teaches verifying the player's identity but does not explain in detail how to accomplish. (Col 5, 19-25) IRS regulations require the casino to fill out Form W2-G for certain jackpots. The instructions for the form require identification numbers from a driver's license, social security card, or voter registration to be inserted into boxes 11 & 12 of the Form W2-G. Thus looking at these documents is required by Bell's disclosure.

Claim 8: Bell teaches that the tax-related information is the player's name and tax identification number (Col 5, 19-25), but does not specifically disclose collecting the address. Bell teaches filling out Form W2-G, which requires the player's address. Thus the collection of the address data is inherent in Bell's disclosure.

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Claim 9: IRS regulations require that the Form W2-G be filed (i.e., reported to a taxing authority) when the jackpot exceeds a certain threshold. While Bell does not specifically disclose filing the paperwork, there would be no other reason to generate the form. Thus Bell teaches reporting the jackpot to the IRS by implication or, in the alternative, it would have been obvious to one of ordinary skill in the art at the time of the invention to have filed the Form W2-G in order to comply with IRS regulations.

Claim 10: Bell teaches providing the player with a statement referencing jackpot information after the player is done playing. (Col 4, 53-60) The W2-G is such a statement.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bell and Acres as applied to claim 1 in view of Bergeron et al. (US Patent Number 4,882,473) and Pease et al. (US Patent Number 5,326,104).

Claim 3: Bell and Acres teach the invention substantially as claimed including the use of a player card. Bell and Acres do not teach inserting an agent card or selecting uninterrupted play from a menu. Bergeron teaches insertion of an agent card for the purpose of enhancing security. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Belle and Acres to require the insertion of an agent card to enhance security as taught by Bergeron. Menus are ubiquitous – virtually every computer system that allows a selection provides a menu. Pease teaches a menu-driven system and states that menu-driven systems are easy to operate. (Col 17, 67-68) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell and Acres to allow the selection of

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uninterrupted play from a menu screen on the display as taught by Pease in order to make the system easy to operate.

6. Claims 20, 21, 26, 34, 45 & 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres as applied to claim 19, 24, 33, or 44 (if applicable) in view of Bergeron et al. (US Patent Number 4,882,473) and Pease et al. (US Patent Number 5,326,104).

Claims 20, 26, 34, 45: Acres teaches the invention substantially as claimed including the use of a player card and the details of network communication and signaling. Acres does not teach inserting an agent card or selecting uninterrupted play from a menu. Bergeron teaches insertion of an agent card for the purpose of enhancing security. (Abstract) Bergeron also teaches entering enabling information (a PIN) into a keypad (72) in communication with the gaming machine. (Col 7, 53-61) This also enhances security. It would have been obvious to one of ordinary skill in the art at the time of the invention to have required the insertion of an agent card and the use of a PIN prior to allowing user access in order to enhance security. While Bergeron appears to allow the agent card (10) to remain in the card reader when the player card is in use, Bergeron has two card readers. Acres teaches a device with one card reader. A machine with one card reader is cheaper than the same machine with two. It would have been obvious to one of ordinary skill in the art at the time of the invention to have removed the agent card from the card reader prior to inserting the user card so that the same card reader could be used for both cards, thus reducing costs.

Menus are ubiquitous – virtually every computer system that allows a selection provides a menu. Pease teaches a menu-driven system and states that menu-driven

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systems are easy to operate. (Col 17, 67-68) It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected uninterrupted play from a menu screen on the display in order to make the system easy to operate.

Claim 21, 46: Acres teaches using data on a player-tracking card to identify the player using a particular machine. Since the card identifies the player that is playing the machine, removing the card would make it impossible to look up the player record as required in step 88 of Fig 3. Therefore, Acres effectively teaches deactivating uninterrupted play when the player removes the card from the card reader.

Response to Arguments

7. Applicant's arguments filed 23 March 2009 have been fully considered but they are not persuasive.

8. Applicant has made amendments to clarify the claims in light of the note on Claim Interpretation included in the last office action. Applicant has not changed the substance of the claims. Therefore the previous rejection stands.

9. Applicant repeats the arguments that have been repeated & answered many times before. Applicant's arguments have been considered by the Board of Patent Appeals and Interferences, which did not consider them persuasive. The arguments do not become more persuasive merely because they are repeated *ad infinitum*.

10. Again Applicant argues that Acres always withholds taxes. Examiner has shown repeatedly that Acres clearly states that it withholds only those amounts that the IRS requires a casino to withhold. As repeatedly noted in the past, Applicant has argued that the IRS does not require withholding. Therefore, the amount that the IRS requires to be withheld is \$0. Thus, in

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Applicant's example, Acres teaches that from a jackpot of \$100,000, zero dollars would be withheld. Thus \$100,000 would be credited to the account. $\$100,000 - \$0 = \$100,000$.

11. Applicant wishes to pick and choose parts of the Acres reference for emphasis & ignore other parts completely. This is not permissible. Examiner must consider the reference as a whole. A fair reading of the Acres reference would be: To the extent that the IRS requires withholding of portions of jackpots over a threshold amount, money can be withheld using the method described in the specification.

12. Applicant's argument about Bell's disclosure says that Bell does not pay the amount until the end of the gaming session. This is exactly what is claim in Applicant's claim 1. Hitting the cash out button signals the end of the gaming session. If the player wins a jackpot & immediately hits the cash out button, Bell pays immediately. Furthermore, Acres explicitly teaches immediate payment. Therefore, the combination certainly teaches immediate availability for cash out of any jackpot winnings.

13. Applicant's statement that the combination of the references would require an attendant ignores Bell's teaching that the attendant is needed when the data needed to fill out the form is not in the player tracking database. Nothing in Bell can fairly be read as requiring the form to be printed & delivered to the player prior to receiving the cash if the player's data is in the database. Furthermore, Acres discloses immediate payout.

14. Applicant's arguments with regard to claim 3, and the rest of the claims, assume that the prior art does not teach uninterrupted play. As Examiner has been pointing out for the past six years, the prior art clearly teaches uninterrupted play.

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Conclusion

15. This is an RCE of applicant's earlier Application No. 09/904061. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Corbett B. Coburn/
Primary Examiner
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